REMARKS

In the February 7, 2005 Office Action, the Examiner:

- Rejected claims 1-7, 18-20, 28-30 and 32 under 35 U.S.C. 102 (e) as being anticipated by Nejedlo *et al.* ("*Nejedlo*", U.S. Pat. App. No. 2004/0117709); and

- Rejected claims 8-10 and 12 under 35 U.S.C. 103(a) as unpatentable over *Nejedlo* in view of Ikeda et al. ("*Ikeda*", U.S. Pat. No. 6,208,571); and

- Noted that he would allow claims 11, 13-17, 21-27 and 31 if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 1-7, 18-20, 28-30 and 32 under 35 U.S.C. 102(e) as being anticipated by *Nejedlo*. For a proper showing that these claims are anticipated by *Nejedlo*, all elements of each rejected claim must be disclosed in the cited reference. The rejected claims contain four independent claims, namely claims 1, 18, 28 and 32, all of which have been amended.

Independent claim 1 now requires that the comparison of the captured first pattern to the first pattern is performed ***at the controller***.[1] In other words, the captured first pattern is transferred from the component capture buffer to the controller[2] where it is compared to the first pattern. This is completely unlike Nejedlo *et al.* which requires a pattern generator 205 (Fig. 3) at the first component 200 and a pattern checker 325 (loaded with the same bits as the pattern generator) at the second component 300.[3] Nejedlo *et al.* also requires that:

> the transmitting agent [the first component 200] may not
> perform any error checking on the pattern and the receiving agent
> [the second component 300] may not transmit any pattern
> information onto the bus. Rather, the receiving agent may compare
> the initially loaded pattern (within the pattern checker 325) with the
> transmitted pattern data from the transmitting agent.[4]

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[1] Support can be found in par. 0035.

[2] *See* dependent claim 5.

[3] *See* 2004/0017709 at par. 0020, 0032 and 0033.

[4] *See* 2004/0017709 at par. 0035.

Accordingly, Nejedlo *et al.* cannot anticipate independent claim 1, nor any claims that depend there from, as Nejedlo *et al.* does not disclose that the comparison of the captured first pattern to the first pattern is performed ***at the controller.***

Furthermore, dependent claims 5-7 require transferring the captured first pattern from the component capture buffer to the controller. The Examiner states that Nejedlo *et al.* discloses this aspect of the invention in par. 42. Despite a thorough reading of Nejedlo *et al.* (including par. 42), Applicants could find no mention of transferring the captured first pattern from the component capture buffer to the controller. In fact, Nejedlo *et al.* expressly teaches away from transferring the captured first pattern from the component capture buffer to the controller.[5] Accordingly, it is respectfully submitted that Nejedlo *et al.* cannot anticipate dependent claims 5-7, as Nejedlo *et al.* does not disloce all the elements of these claims.

Independent claim 18 now requires a ***link*** between the second component and the first component. The link is configured to transfer the captured pattern from the second component to the first component for comparison with the pattern. For at least the reasons presented above, Nejedlo *et al.* cannot anticipate independent claim 18, nor any claims that depend there from, as Nejedlo *et al.* does not disclose a ***link*** between the second component and the first component that is configured to transfer the captured pattern from the second component to the first component for comparison with the pattern.

Similarly, independent claim 28 now requires a ***link*** between the memory device and the memory controller. The link is configured to transfer the captured pattern from the memory to the memory controller for comparison with the pattern. For at least the reasons presented above, Nejedlo *et al.* cannot anticipate independent claim 28, nor any claims that depend there from, as Nejedlo *et al.* does not disclose a ***link*** between the memory device and the memory controller that is configured to transfer the captured pattern from the memory to the memory controller for comparison with the pattern.

As above, independent claim 32 now requires a ***link*** means between the second component and the first component. The link means is configured to transfer the captured test pattern from the second component to the first component for comparison with the test pattern. For at least the reasons presented above, Nejedlo *et al.* cannot anticipate independent claim 32, nor any claims that depend there from, as Nejedlo *et al.* does not disclose a ***link*** between the second component and the first component that is configured to transfer the

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[5] *See* 2004/0017709 at par. 0035.

captured test pattern from the second component to the first component for comparison with the test pattern.

Accordingly, in light of the amendments made to independent claims 1, 18, 28 and 32, Nejedlo *et al.* cannot anticipate any of these independent claims, or any claims that depend there from. Therefore, it is respectfully requested that the rejection of claims 1-7, 18-20, 28-30 and 32 under 35 U.S.C. 102 (e) be withdrawn.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 8-10 and 12 under 35 U.S.C. 103(a) as unpatentable over Nejedlo *et al.* in view of Ikeda. To establish a prima facie case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. [6]

The Examiner states that Nejedlo *et al.* teaches all the limitations of claims 8, 10, and 12 except the limitation of loading a second pattern into the memory device via a serial link, *etc.* For at least the reasons stated above, Nejedlo *et al.* does not disclose, teach or suggest many of the elements of the independent claims. Accordingly, it is respectfully submitted that claims 8, 10 and 12 cannot be unpatentable over Nejedlo *et al.* in view of Ikeda, as the prior art references do teach or suggest all the claim limitations.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant encourages the Examiner to call the undersigned attorney at 650-843-7519 to set up an interview.

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[6]   *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 060809-0139-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

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